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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/852,119	05/06/97	JONES M	507011026

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EXAMINER
LOUIS JACQUES, J

ART UNIT	PAPER NUMBER
3661	

DATE MAILED: 03/09/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/852,119**

Applicant(s):  
**JONES**

Examiner  
**Jacques H. Louis-Jacques**

Group Art Unit  
**3661**



☒ Responsive to communication(s) filed on Feb 8, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-21 and 23-49 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-21 and 23-49 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 9

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. This office action is responsive to communication filed on February 8, 1999.

***Claim Rejections - 35 U.S.C. § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1-14, 27-28, 31-35, 37-41, 43-47 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Ross [5,444,444].

Ross '444 discloses an apparatus and method of notifying a recipient of an unscheduled delivery. The vehicle is equipped with a satellite receiver, a controller and a communicator. The position of the vehicle is determined based on positioning data or signals. The controller compares the current vehicle location or position to the location in the mapped are. The communicator then communicates with the user to notify user. As shown in figure 1, there are provided controllers (10 and 21), a video screens or computer displays (14 and 26). As described in column 2, a time interval (timing information) and distance (distance information) are computed. Ross discloses the time period, and the predetermined distance as well as the telephone interface or communication. Also, a message or notification is forwarded to user via a telephone associated therewith. See

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column 6. As explained, more specifically in the claim section, Ross discloses a voice generator for generating or producing n audible message to notify the party.

4. Claims 1-14, 27-28, 31-35, 37-41, 43-47 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Ross [5,648,770].

Ross '770 discloses an apparatus and method of notifying a party of a pending delivery or pickup. A mobile receiver or carrier is equipped with a satellite receiver, a controller and a communicator. The position of the vehicle is determined based on positioning data or signals. The controller compares the current vehicle location or position to the location in the mapped are. The communicator then communicates with the user to notify user. As shown in figure 1, there are provided controllers (10 and 21), a video screens or computer displays (14 and 26). As disclosed in column 2, an analyzer evaluates the positioning signals to determine the position of the carrier, the position of the carrier is compared with a predetermined location, a time interval is computed, and when the time interval is less than a predetermined time interval, a signal is communication to provide reasonable advance notice. See column 2. Also, a message or notification is forwarded to user via a telephone associated therewith. See columns 5 and 6. As explained, more specifically in the claim section, Ross discloses a voice generator for generating or producing an audible message to notify the party. Ross discloses the time period, and the predetermined distance as well as the telephone interface or communication.

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***Claim Rejections - 35 U.S.C. § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 36, 42 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross [5,648,770], in the alternative Ross [5,444,444].

While neither Ross '770 nor Ross '444 specifically teaches the communication over the Internet, it would have been obvious to one skilled in the art at the time of the invention to be motivated to incorporate the use of the Internet into the Ross apparatuses and methods because such modification will enable to communicate with a various numbers of parties all over the world.

***Response to Arguments***

7. The arguments filed on February 8, 1999 have been entered and carefully considered by the examiner.

Summary of the prior office action:

Objection to the drawings.

Double Patenting - The claims were found obvious over US Patents 5,668,543; 5,657,010, 5623,260; and 5,400,020.

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35 U.S.C. 102(e) - Some of the claims were found anticipated by Ross [5,648,770 and 5,444,444].

35 U.S.C. 103(a) - The remaining were found obvious over Ross [5,648,770 and 5,444,444].

Correction in the prior office action:

The Ross patent [5,444,444] has been published more than a year of the US filing date of the present application. Therefore, the rejection under 102 should have been a 102(b) rejection instead of a 102(e) rejection.

Now let's turn to applicant's arguments.

In light of the Terminal Disclaimers filed on February 8, 1999, the rejections under Double Patenting have been withdrawn.

a) Applicant asserted that "[t]he fact that an application named a different inventive entity than a patent does not constitute necessarily make that patent prior art.", citing *Applied Materials Inc. V. Gemini Research corp.* The examiner agrees. *However, if the patent has an earlier US effective filing date than the application, such patent is considered to be prior art.*

b) Applicant continued by stating that, citing *In re DeBaun*, "[A]n applicant's own work, even though publicly disclosed prior to his application, may not be used against him as a reference, absent the existence of a time bar to his application." The examiner agrees. *However, this only applies to the same applicant for the patent and the application. By same applicant, it's meant the same inventive entity.*

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Applicant further asserted that "an applicant may overcome a rejection based on a patent 'by showing that the patent disclosure is a description of applicant's own previous ...'" The examiner agrees. However, this can only happen in the case where i) applicant is one of a group of inventors of the patent or ii) the application and the patent are assigned to the same assignee.

The present application named only one inventor, M.K. Jones. In order for any of the conditions a) or b) above applies, the patent in question must have M.K. Jones as one of its inventors. Even if the patent in question named M.K. Jones as an inventor, condition b) would not have applied because that would constitute a different inventive entity.

In the case of the present situation, the patents applied against the claims of the present application are Ross [5,444,444] and Ross [5,648,770], both of which named only one inventor John Ross. Therefore, the Ross patents do not apply to conditions a) nor b).

In regard to applicant's analysis of the '770 Ross patent, such is not the case here. Ross [5,648,770] is still considered prior art against the claims of the present application.

35 U.S.C. 102(e) states that: the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by applicant for patent, or

The MPEP states that a rejection can be overcome by: (3) Filing an affidavit or declaration under 37 CFR 1.132 showing that the reference invention is not by "another." See MPEP § 715.01(a), § 715.01(c), and § 716.10.

That is, in order for the affidavit to be acceptable, it must meet the requirements of MPEP § 715.01(a), § 715.01(c), and § 716.10.

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**MPEP § 715.01(a)** Reference Is a Joint Patent to Applicant and Another [R - 1]

When subject matter, disclosed but not claimed in a patent issued jointly to S and another, is claimed in a later application filed by S, the joint patent is a valid reference unless overcome by affidavit or declaration under 37 CFR 1.131 or an unequivocal declaration under 37 CFR 1.132 by S that he/she conceived or invented the subject matter disclosed in the patent and relied on in the rejection. In re DeBaun , 214 USPQ 933 (CCPA 1982). See MPEP § 716.10 for a discussion of the use of 37 CFR 1.132 affidavits or declarations to overcome rejections by establishing that the subject matter relied on in the patent was the invention of the applicant. Disclaimer by the other patentee should not be required but, if submitted, may be accepted by the examiner.

Although affidavits or declarations submitted for the purpose of establishing that the reference discloses applicant's invention are properly filed under 37 CFR 1.132, rather than 37 CFR 1.131, such affidavits submitted improperly under 37 CFR 1.131 will be considered as though they were filed under 37 CFR 1.132 to traverse a ground of rejection. In re Facius , 408 F.2d 1396, 161 USPQ 294 (CCPA 1969).

*That is NOT the case here. The present application and the patent has no common inventor, i.e., the patent was NOT issued jointly by John Ross and Martin Kelly Jones.*

**MPEP § 715.01©** Reference Is Publication of Applicant's Own Invention [R - 2]

Unless it is a statutory bar, a rejection based on a publication may be overcome by a showing that it was published either by applicant himself/herself or on his/her behalf. Since such a showing is not made to show a date of invention by applicant prior to the date of the reference under 37 CFR 1.131, the limitation in 35 U.S.C. 104 and in 37 CFR 1.131(a)(1) that only acts which occurred in this country or in a NAFTA or WTO member country may be relied on to establish a date of invention is not applicable. Ex parte Lemieux , 115 USPQ 148, 1957 C.D. 47, 725 O.G. 4 (Bd. App. 1957); Ex parte Powell \*\*, 1938 C.D. 15, 489 O.G. 231 (Bd. App. 1938). See MPEP § 716.10 regarding 37 CFR 1.132 affidavits submitted to show that the reference is a publication of applicant's own invention.

**COAUTHORSHIP**

Where the applicant is one of the co - authors of a publication cited against his or her application, he or she may overcome the rejection by filing an affidavit or declaration under 37 CFR 1.131. Alternatively, the applicant may overcome the rejection by filing a specific affidavit or declaration under 37 CFR 1.132 establishing that the article is describing applicant's own work. An affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that



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the others were merely working under his direction is sufficient to remove the publication as a reference under 35 U.S.C. 102(a). In re Katz, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

#### DERIVATION

When the unclaimed subject matter of a patent or other publication is applicant's own invention, a rejection on that patent or publication may be removed by submission of evidence establishing the fact that the patentee or author derived his or her knowledge of the relevant subject matter from applicant. Moreover applicant must further show that he or she made the invention upon which the relevant disclosure in the patent or publication is based. In re Mathews , 408 F.2d 1393, 161 USPQ 276, 56 CCPA 1033 (CCPA 1969); In re Facius , 408 F.2d 1396, 161 USPQ 294, 56 CCPA 1384 (CCPA 1969).

*That is NOT the case here. The patent is by John Ross.*

#### MPEP § 716.10 Attribution

Under certain circumstances an affidavit or declaration may be submitted which attempts to attribute a reference or part of a reference to the applicant. If successful, the reference is no longer applicable. When subject matter, disclosed but not claimed in a patent application issued jointly to S and another, is claimed in a later application filed by S, the joint patent is a valid reference available as prior art under 35 U.S.C. 102(a), (e), or (f) unless overcome by affidavit or declaration under 37 CFR 1.131 showing prior invention (see MPEP § 715) or an unequivocal declaration by S under 37 CFR 1.132 that he or she conceived or invented the subject matter disclosed in the patent. Disclaimer by the other patentee should not be required but, if submitted, may be accepted by the examiner.

Where there is a published article identifying the authorship (MPEP § 715.01(c)) or a patent identifying the inventorship (MPEP § 715.01(a)) that discloses subject matter being claimed in an application undergoing examination, the designation of authorship or inventorship does not raise a presumption of inventorship with respect to the subject matter disclosed in the article or with respect to the subject matter disclosed but not claimed in the patent so as to justify a rejection under subsection (f).

However, it is incumbent upon the inventors named in the application, in response to an inquiry regarding the appropriate inventorship under subsection (f) or to rebut a rejection under 35 U.S.C. 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the author or patentee notwithstanding the authorship of the article or the inventorship of the patent. In re Katz , 687 F.2d 450, 215 USPQ 14,18 (CCPA 1982) (inquiry is appropriate to clarify any ambiguity created by an article

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regarding inventorship and it is then incumbent upon the applicant to provide "a satisfactory showing that would lead to a reasonable conclusion that [applicant] is the ... inventor" of the subject matter disclosed in the article and claimed in the application).

An uncontradicted "unequivocal statement" from the applicant regarding the subject matter disclosed in an article or patent will be accepted as establishing inventorship. In re DeBaun , 214 USPQ 933, 936 (CCPA 1982). However, a statement by the applicants regarding their inventorship in view of an article or a patent may not be sufficient where there is evidence to the contrary. Ex parte Kroger , 218 USPQ 370 (Bd. App. 1982) (a rejection under 35 U.S.C. 102(f) was affirmed notwithstanding declarations by the alleged actual inventors as to their inventorship in view of a nonapplicant author submitting a letter declaring the author's inventorship); In re Carriera , 189 USPQ 461 (CCPA 1976) (disclaiming declarations from patentees were directed at the generic invention and not at the claimed species, hence no need to consider derivation of the subject matter).

A successful 37 CFR 1.132 affidavit or declaration establishing derivation by the author or patentee of a first reference does not enable an applicant to step into the shoes of that author or patentee in regard to its date of publication so as to defeat a later second reference. In re Costello , 717 F.2d 1346, 219 USPQ 389, 392 (Fed. Cir. 1983).

*That is not the case here.*

Even with the EXAMPLES provided in the MPEP, the present situation is NOT applicable.

The following examples demonstrate the application of an attribution affidavit or declaration.

#### Example 1

During the search the examiner finds a reference fully describing the claimed invention. The applicant is the author or patentee and it was published or patented less than one year prior to the filing date of the application. The reference cannot be used against applicant since it does not satisfy the 1 - year time requirement of 35 U.S.C. 102(b).

#### Example 2

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Same facts as above, but the author or patentee is an entity different from applicant. Since the entities are different, the reference is prior art under 35 U.S.C. 102(a) or (e).

In the situation described in Example 2, an affidavit under 37 CFR 1.132 may be submitted to show that the relevant portions of the reference originated with or were obtained from applicant. Thus the affidavit attempts to convert the fact situation from that described in Example 2 to the situation described in Example 1.

The same discussion applied to the 103(a) rejection.

Therefore, it is found that both the Ross [5,648,770 and 5,444,444] are prior art against the claims of the present application. The mere fact that a different section of 102 is used does not constitute new ground of rejection. The rejections are sustained and this office action is made final.

### *Conclusion*

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jacques H. Louis-Jacques** whose telephone number is (703) 305-9757.

Any inquiry of a general nature or relating to the status of this application should be directed to the **Group Receptionist** whose telephone number is (703) 308-1113.

10. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks  
Washington, D.C. 20231**

or faxed to:

(703) 305-7687, (for formal communications intended for entry, please indicate as so; and for informal or draft communications, please label "PROPOSED" or "DRAFT")

/jlj  
March 4, 1999

*Jacques Louis-Jacques*  
**JACQUES H. LOUIS-JACQUES**  
**PRIMARY EXAMINER**